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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,500	05/31/2001	Jeou-En Hsu	MR2723-79	9054

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EXAMINER

YE, LIN

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/867,500

Applicant(s)

HSU, JEOU-EN

Examiner

Lin Ye

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 and 2 recite the limitation "... **the** exposing portions..." and "... **the** circuit substrate..." in page 8, lines 9-10 and lines 20-21. There is insufficient antecedent basis for this limitation in the claim.

Appropriate correction is required.

For examination purpose, these claims will be interpreted as they are best understood.

3. Claim 4 recites the limitation "... **the** residue sheets..." in page 9, lines 9-10. There is insufficient antecedent basis for this limitation in the claim.

Appropriate correction is required.

For examination purpose, these claims will be interpreted as they are best understood.

4. The claims 1-2 and 4 are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Referring to claims 1-2, in page 8, lines 9-10 and lines 20-21, "encasing the circuit substrate closing by silicon using by a front and a rear casing..."

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Referring to claim 4, in page 9, lines 9-12, "... LCD display screen for displaying the **residue sheets...**".

Appropriate correction is required.

For examination purpose, these claims will be interpreted as they are best understood.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 3 (depending on claim 1) are rejected under 35 U.S.C. 102(e) as being anticipated by Silverbrook et al. U.S. Publication 2004/0032501.

Referring to claim 1, the Silverbrook reference discloses in Figures 1, 2, 3 and 11, a method for manufacturing a digital camera with a function of a pen (e.g., a compact device about the size of a pen includes a camera module in Figure 2, pen module in Figure 11, print module in Figure 1 and memory module in Figure 3, etc.; and these modules can attach to the system together) comprising the step of: making a circuit module (integrated circuit as an image processor 243 in Figure 23, see page 6, [0099]) and a photo capture module (Area CMOS image sensor 241) at the same substrate (flexible printed circuit board 242, see page 5, [0085]); fixing the circuit module (243) and photo capture module (241) by silicon (e.g.,

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the CMOS 241 and ASIC 243 chips are formed by semiconductor material, such, silicon inherently, see page 5, [0085]) matching forms of a casing (camera module 20, see page 2, [0050]), a lens (23 in Figure 2), an LCD display screen (242 in Figure 23), I/O ports (camera connector 22 connects with communications module 40 as shown in Figure 4 as function of a I/O port, see page 3, [0053]), and a control portion for controlling the key set (buttons 243 in Figure 23 and take button 27 in Figure 2); encasing the circuit substrate closing by silicon using by a front and a rear casing (in Figure 19, the front and a rear casing 213 encasing the circuit substrate 242 which including the CMOS 241 and ASIC circuit 243 formed by silicon material), and shutter button 271 (consider as a exposing portions) matching to the respective portions of the casing (parallel interface 241) as shown in Figure 19 (see page 5, [0091]); and inserting a pen (110) into a pen cover (111, See page 3, [0061] and Figure 11).

Referring to claim 3 (depending on claim 1), the Silverbrook reference discloses wherein to matching the casing (chassis molding 213), the circuit module (243) and photo capture module are made at the same circuit substrate (flexible printed circuit board 242, see page 5, [0085]).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook et al. U.S. Publication 2004/0032501 in view of Mikkelsen U.S. Patent 5,379,928.

Referring to claim 4, the Silverbrook reference discloses in Figures 1,2, 3 and 11, a digital camera having functions of a digital camera (as shown in Figure 2) and a pen (as shown in Figure 11), an embedding memory (image Ram 234, see page 6, [0105]) being used to record an image, and then an I/O port (communication port 40 in Figure 4) being used to transfer the image to a receiving end; the digital camera (20) with a function of a pen (110) comprising: a casing module formed by a front casing and a rear casing in Figures 19-20, a photo capture frame (24); a window (view finder 25) having a transparent plate for viewing the object to be captured; an LCD display screen 242 in Figure 23, see page 6, [0102]) for displaying the reside sheets (images); an I/O port position (camera connector 22 connects with communications module 40 as shown in Figure 4 as function of a I/O port, see page 3, [0053]); a pen cover (111), a key set (as applicant has disclosed the key set including a photo button for camera control operation. For this reason, the Silverbrook discloses the photo taken button 27 in Figure 2 or camera buttons 243 in Figure 23 can be consider as the key set); a circuit module having a microprocessor (Micro controller 236), a memory (234), a counting circuit (CPU including a clock 245 for providing timing signals), power supply circuit (battery in the printer module, see page 4, [0065]), and an output port (camera connector 22 connects with communication module 40) for transferring photograph data in a memory to a receiving end (e.g. images can be transferred to the computer, see page 3, [0053]); and a photo capture module (20) having a photo lens (23, see page 2, [0050]); wherein by the circuit module and photo capture module, a compact portable digital camera

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with a function of a pen is formed, the user can record data by photographs and writing by a pen. However, the Silverbrook reference does not explicitly show the detail of the pen cover that has a buckling ring for hanging the digital pen camera device on the neck; and the pen cover being at a lower end of the casing and having tenons at an inner periphery for buckling a pen not to drop out.

The Mikkelsen discloses in Figures 1-6, a holder (13) having pen cover shape so as to hold an object (15) having pen shape. The holder has buckling ring (tab 27) for hanging the object the neck (See Col. 4, lines 50-60). The holder being at a lower end of casing and having tenons (receptacle 39 formed interior vertical walls 41) at an inner periphery for buckling the object not to drop (See Col. 5, lines 27-34). The Mikkelsen reference is evidence that one of ordinary skill in the art at the time to see more advantages for the compact object such as a compact pen camera device can be hang on the neck so that user can be hand free and easy to carry out. For that reason, it would have been obvious to see the pen cover that has a buckling ring for hanging the digital pen camera device on the neck; and the pen cover being at a lower end of the casing and having tenons at an inner periphery for buckling a pen not to drop out disclosed by Silverbrook.

Referring to claim 7, the Silverbrook reference discloses wherein the I/O port ((camera connector 22 connects with communications module 40 as shown in Figure 4 as function of a I/O port) is a USB port (See page 3, lines 0053)).

9. Claims 2, claim 3 (depending on claim 2) and 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook et al. U.S. Publication 2004/0032501 in view of Mikkelsen U.S. Patent 5,379,928 and Takahashi U.S. Patent 5,208,623.

Referring to claims 2 and 5, the Silverbrook and Mikkelsen references discloses all subject matter as discussed in respected claims 1 and 4, and the Mikkelsen reference shows that covering a buffering rubber pad (e.g., an electrometric material, see page 5, lines 34-41) for increasing friction force to holder the object. However, the references do not explicitly show also covering the buffer rubber pad on the key set for enhancing a friction force.

The Takahashi references discloses in Figures 1 and 7, the camera has buffering rubber pad (switch rubber unit 66) for the key set (operation buttons, such as mode switching button 12 and power button 14, see Col. 9, lines 18-27). The Takahashi reference is evidence that one of ordinary skill in the art at the time to see more advantages for using the rubber material for the camera operation buttons so that rubber buttons provides enough frictional force to the switch to make it easy to operate the camera by hand while allowing the camera operation modes to remain firmly in place after a position is selected. For that reason, it would have been obvious to see the compact pen camera device installed with a buffer rubber material to the key set and pen cover for enhancing a friction force disclosed by Silverbrook.

Referring to claim 3 (depending on claim 2), the Silverbrook reference discloses all subject matter as discussed in respected claim 3 (depending on claim 1),

Referring to claim 6, the Silverbrook and Mikkelsen references discloses all subject matter as discussed in respected claims 1 and 4, and the Silverbrook reference shows the key set (operation button) includes photograph button (take button 27, see page 3, [0050]) or other operation buttons (243 as shown in Figure 23). However the reference does not explicitly show a power switch buttons.

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The Takahashi reference discloses the camera key set includes power switch button for turning the power ON and OFF as shown in Figure 1 (See Col. 2, lines 44-47). The Takahashi reference is evidence that one of ordinary skill in the art at the time to see more advantages for the camera system has power switch for turning the power ON and OFF so that the user can regulate the camera power consumption more easily and efficiently. For that reason, it would have been obvious to see the key set of compact pen camera device includes a power switch disclosed by Silverbrook.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. King et al. U.S 6,550,997 discloses a pen image device in Figure 1.
- b. Heller U.S. 6, 396,539 discloses a single integrated circuit having an image sensor and an image processing.
- c. Wang U.S. 2001/0051068 discloses a hanging pen comprises a pen cap.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Lin Ye** whose telephone number is **(703) 305-3250**. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Christensen can be reached on (703) 308-9644.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

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Washington, DC. 20231

Or faxed to:

(703) 872-9306

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal drive,
Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or
proceeding should be directed to the Technology Center 2600 Customer Service Office
whose telephone number is (703) 306-0377.



ANDREW CHRISTENSEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

Lin Ye
August 23, 2004